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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,862	07/31/2003	Masahiro Kojima	116753	9070
25944	7590	11/03/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			COOKE, COLLEEN P	
			ART UNIT	PAPER NUMBER
			1754	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,862

Applicant(s)

KOJIMA ET AL.

Examiner

Colleen P. Cooke

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

Applicant's election with traverse of Group I, Claim 1 in the reply filed on 9/12/05 is acknowledged. The traversal is on the ground(s) that the product cannot be made by another process. This is not found persuasive because the applicant simply asserts that their method of producing the Bi-2223 thick film is superior to other methods but provides no evidence to overcome the restriction.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(a and e) as being anticipated by Kojima et al. (2003/0096709).

Kojima et al. teaches an oxide superconductor thick film having the composition $(\text{Bi,Pb})_{2+a}\text{Sr}_2\text{Ca}_2\text{Cu}_3\text{O}_z$ where $0 < a < 0.5$ (paragraph 0022). Furthermore, Kojima et al. teaches that the thick film does not peel (paragraphs 0038-0039) and exhibits similar properties to those described in the applicant's specification (see paragraph 0057 and Figures 1 and 2A). It would

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appear that the superconducting thick film of Kojima et al. meets the claim limitations; though Kojima et al. is silent as to any "fracture surface" Kojima et al. does teach that the film specifically avoids the prior art problem of peeling and exhibits excellent superconducting characteristics which therefore lead the examiner to believe that the superconductor has no such fracture surface as it does not exhibit the peeling or poor properties associated with such a fracture surface.

It is noted that Kojima et al. (2003/0096709) is a Pre-Grant Publication and the applicant has since issued as US 6,809,042.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Kojima et al. (6,809,042).

Kojima et al. teaches an oxide superconductor thick film having the composition $(\text{Bi,Pb})_{2+a}\text{Sr}_2\text{Ca}_2\text{Cu}_3\text{O}_z$ where $0 < a < 0.5$ (Column 2, lines 45-55). Furthermore, Kojima et al. teaches that the thick film does not peel (Column 3, line 49 - Column 4, line 6) and exhibits similar properties to those described in the applicant's specification (see Column 5, lines 25-34 and Figures 1 and 2A). It would appear that the superconducting thick film of Kojima et al. meets the claim limitations; though Kojima et al. is silent as to any "fracture surface" Kojima et al. does teach that the film specifically avoids the prior art problem of peeling and exhibits excellent superconducting characteristics which therefore lead the examiner to believe that the superconductor has no such fracture surface as it does not exhibit the peeling or poor properties associated with such a fracture surface.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Colleen P Cooke whose telephone number is 571-272-1170. She can normally be reached Mon.-Thurs. 8am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, her supervisor, Stan Silverman can be reached at 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Colleen P Cooke
Primary Examiner
Art Unit 1754